

REMARKS

The above-identified application has been considered in view of the Final Office Action that was mailed on July 21, 2009. Claims 10-28 are currently pending. By the present Amendment, Applicants have amended independent claim 25 to remedy a typographical error. Applicants respectfully submit that this amendment does not introduce any new matter, is fully supported by the specification, and does not necessitate any further searching by the Examiner. In view of the following remarks and arguments, Applicants respectfully submit that each of the pending claims is allowable over the references of record, and accordingly, respectfully request reconsideration and allowance of these claims.

Claims 10, 14-16, 19, and 21-28 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,573,540 to Yoon (hereinafter "Yoon"). Applicants respectfully submit, however, that Yoon fails to disclose each and every element recited in claims 10, 11, 14-16, and 21-28.

Under MPEP § 2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

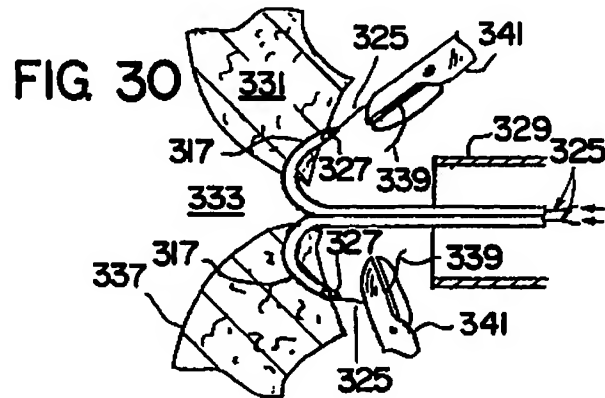
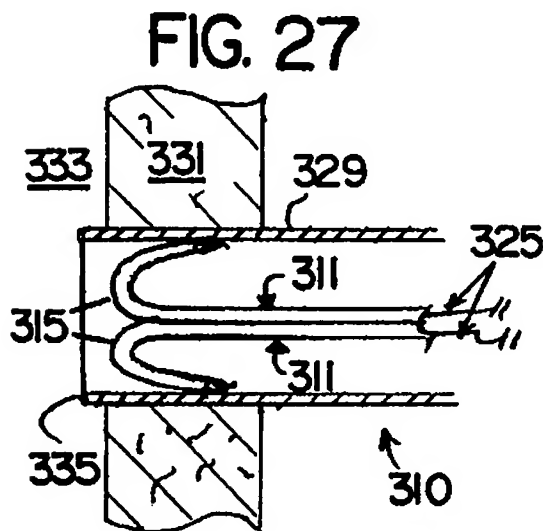
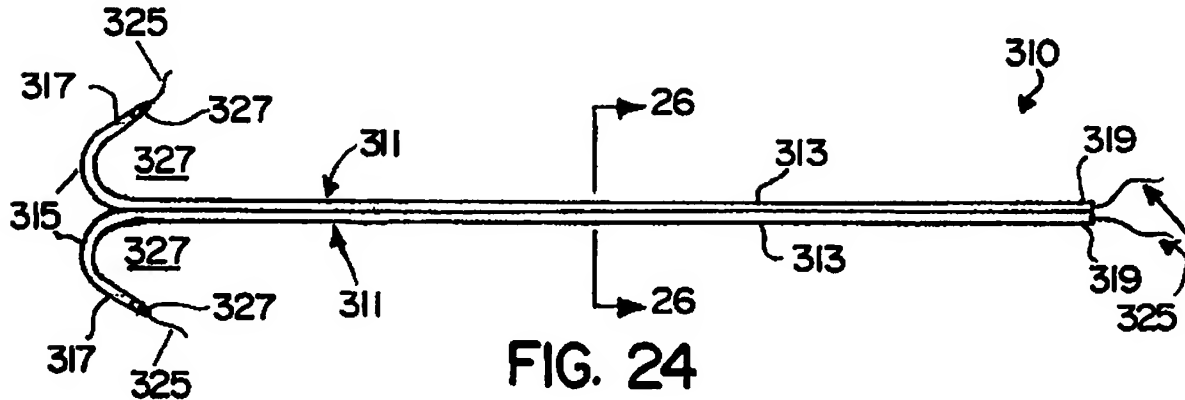
Independent claim 10 recites "[a]n apparatus for substantially closing a vascular opening in a vessel while permitting post operative blood flow through said vessel" that includes "a housing," "at least two tissue engaging members disposed adjacent the distal end of the housing, said tissue engaging members being longitudinally and reciprocally movable relative to said housing between a retracted position and an

advanced position,” and “at least two jaw members positioned adjacent said tissue engaging members and being movable independently thereof.”

Independent claim 25 recites “[a]n apparatus for substantially closing a vascular opening in a vessel while permitting post operative blood flow through said vessel” that includes “a housing,” “a pair of tissue engaging members at least partially extending from the housing, the pair of tissue engaging members being longitudinally and reciprocally movable relative to said housing between a retracted position and an advanced position,” and “a pair of jaw members disposed adjacent the tissue engaging members.”

Yoon “relates generally to surgical instruments and procedures,” and more particularly, “to an apparatus and method for suturing an opening in anatomical tissue, such as a puncture site created for introduction of instruments during endoscopic and other minimally invasive procedures.” (Col. 1, lines 7-12). In one embodiment of the disclosure, Yoon describes a closure apparatus 310 including two or more outwardly turned hooks 311 each having a hollow leg 313 that allows a length of suture material 325 to pass therethrough. (See col. 8, line 62 – col. 9, line 11; FIG. 24 below). According to Yoon, during use, a portal sleeve or cannula 329 is positioned within the wall 331 of an anatomical cavity 333 through a puncture site, whereby the sleeve 329 acts as a housing or portal for passage of medical instruments into the anatomical cavity 333. (See col. 9, lines 25-32; FIG. 27 below). Following passage through the sleeve 329, the closure apparatus 310 is retracted proximally to cause the tips 317 of the legs 313 to penetrate into the tissue of the cavity wall 331 surrounding the puncture site, and the

suture material 325 is grasped using forceps 341, or the like. (See col. 9, lines 43-53; FIG. 30 below).



In the Final Office Action, the sleeve 329, the hooks 311, and the forceps 341 were respectively characterized as the claimed "housing," "tissue engaging members," and "jaw members." (See Final Office Action, pages 2-3).

As indicated above, according to Yoon, following proximal retraction of the closure apparatus 310, the forceps 341 are introduced to grasp the free ends 339 of the suture material 325. (See col. 9, lines 47-53). Yoon is devoid of any disclosure, either in

the written description or in the figures, that would allow one of ordinary skill in the art to reasonably conclude that the forceps 341 are a component of the apparatus 310. The forceps 341 are not attached or connected to the apparatus 310 in any way, shape, or form, and constitute an entirely separate, distinct surgical instrument altogether. Any conclusion to the contrary is simply unsupported by Yoon.

In contrast, independent claims 10 and 25 each recite a single “apparatus for substantially closing a vascular opening in a vessel” that includes “a housing,” “at least two tissue engaging members,” and “jaw members.” In other words, the claimed “jaw members” constitute a component of the claimed “apparatus,” rather than an additional instrument comprising a part of an overall system, such as that disclosed in Yoon.

Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that Yoon fails to disclose each and every element recited in independent claims 10 and 25, and consequently, that Yoon fails to anticipate the subject matter of independent claims 10 and 25. As such, Applicants respectfully submit that independent claims 10 and 25 are allowable over Yoon under 35 U.S.C. §102(b). Since claims 14-16, 19, 21-24, and 26-28 depend either directly or indirectly from independent claims 10 and 25, and include each element recited therein, for at least the reasons that independent claims 10 and 25 are allowable over Yoon under 35 U.S.C. §102(b), *inter alia*, Applicants respectfully submit that claims 14-16, 19, 21-24, and 26-28 are also allowable over Yoon under 35 U.S.C. §102(b).

Claims 11-13, 17, 18, and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yoon. Applicants respectfully submit, however, that Yoon fails to render the subject matter of claims 11-13, 17, 18, and 20 obvious.

As a condition for patentability, 35 U.S.C. §103(a) indicates that “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art,” then the subject matter is not patentable. (Emphasis added).

In the Office Action, it was acknowledged that Yoon fails to disclose the incorporation of a “shape memory material,” as recited in claim 11, or “conductive” materials, as recited in claims 17 and 18, but it was argued that such materials are well known in the art, and that their inclusion would have been obvious to one of ordinary skill in the art. (*See* Final Office Action, page 4). Additionally, regarding claim 20, it was acknowledged that Yoon fails to disclose a “spring member . . . to bias said jaw members towards the closed position,” as recited in claim 20, and it was again argued that such structure is known in the art, and that the inclusion thereof would have been obvious to one of ordinary skill in the art. (*See* Final Office Action, pages 4-5).

As previously discussed, Yoon fails to disclose a single “apparatus for substantially closing a vascular opening in a vessel” that includes “a housing,” “at least two tissue engaging members,” and “jaw members,” as recited in independent claim 10, and describes instead a system that includes a closure apparatus and a forceps apparatus.

Assuming, *arguendo*, that the arguments set forth in the Office Action regarding the knowledge of one of ordinary skill as it pertains to “shape memory

material,” “conductive” materials, and a “spring member . . . to bias said jaw members towards the closed position,” the incorporation of one or more of these features would fail to cure the aforescribed deficiencies in Yoon.

Accordingly, and for at least this reason, *inter alia*, Applicants respectfully submit that Yoon fails to suggest the subject matter of independent claim 10 as a whole, and therefore, that Yoon fails to render the subject matter of independent claim 10 obvious. As such, Applicants respectfully submit that independent claim 10 is allowable over Yoon under 35 U.S.C. §103(a). Since claims 11-13, 17, 18, and 20 depend either directly or indirectly from independent claim 10, and include each element recited therein, for at least the reasons that independent claim 10 is allowable over Yoon under 35 U.S.C. §103(a), *inter alia*, Applicants respectfully submit that claims 11-13, 17, 18, and 20 are also allowable over Yoon under 35 U.S.C. §103(a).

Claim 10 was rejected on the ground of non-statutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,248,124 (hereinafter “the ‘124 patent”). However, as argued in the Amendment that was filed on April 14, 2009, Applicants respectfully submit that independent claim 10 recites subject matter that is patentably distinguishable from the subject matter recited in claim 1 of the ‘124 patent.

As an example illustrating the difference in claim scope between claim 10 of the present application and claim 1 of the ‘124 patent, Applicants point out that claim 10 fails to recite “an electrode associated with at least one of the first and second jaw members,” as recited in independent claim 1 of the ‘124 patent.

In the Final Office Action, it was argued that “[n]ot using an electrode and merely using a housing, two tissue engaging members and two jaw members is

considered obvious to one having ordinary skill in the art because a vessel opening can be closed with only those elements.” (Final Office Action, page 6). Even if it is assumed, *arguendo*, that this argument is accurate, claim 1 of the ‘124 patent would still fail to recite “at least two tissue engaging members . . . each having a distal segment arranged in a general hook or J-shaped configuration, said distal segments being disposed in general diametrical opposed relation and generally curving away from the longitudinal axis when said tissue engaging members are in said advanced position,” as currently recited in claim 10.

Given these differences in structure between the subject matter recited in claim 10 of the present application and claim 1 of the ‘124 patent, Applicants respectfully submit that the subject matter recited in amended independent claim 10 is patentably distinct from that recited in claim 1 of the ‘124 patent. Accordingly, Applicants respectfully submit that the rejection of claim 10 on the ground of non-statutory obviousness-type double patenting over claim 1 of the ‘124 application is legally insufficient, and as such, respectfully request withdrawal of the rejection.

In view of the foregoing remarks and arguments, Applicants respectfully submit that claims 10-28 are allowable over the references of record, and accordingly, respectfully request reconsideration and allowance of these claims.

Should the Examiner have any questions concerning this Amendment, or feel that an interview would be helpful in resolving any outstanding matters, the Examiner is sincerely invited to contact Applicants’ undersigned attorney at the number indicated below.

Please charge any deficiency, as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550. Also, in the event that any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required, and charge Deposit Account No. 21-0550 therefor.

Respectfully submitted,



Michael J. Debono

Reg. No. 62,877

Attorney for Applicants

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road, Suite 420
Melville, New York 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526

Send correspondence to:
Chief Patent Counsel
COVIDIEN
60 Middletown Avenue
North Haven, Connecticut 06473